

REMARKS

This amendment is a complete response to the non-final Office Action mailed on September 20, 2006. In this Office Action, the Examiner has noted that claims 1-41 are pending; that claims 1-16, 21, 22, and 28 have been objected to; that claims 16-29 stand rejected under 35 U.S.C. 112; that claims 1-15 and 30-41 stand rejected under 35 U.S.C. 102(e); and that claims 16-29 stand rejected under 35 U.S.C. 103(a).

By this response, claims 1, 8, 9, 11, 16 and 23 have been amended. Claims 1, 8, 11, 16, and 23 have been amended to define more clearly the subject matter therein. The amendments to the claims are believed to be proper and justified. No new matter has been added.

In view of both the amendments presented above and the following remarks, it is submitted that the claims pending in the application are novel and nonobvious. It is believed that this application is in condition for allowance. By this response, reconsideration of the present application is respectfully requested.

CITED ART

The Action cites U.S. Patent No. 6,785,290 issued to Fujisawa et al. (hereinafter referenced as "Fujisawa"), U.S. Patent No. 6,049,550 issued to Baydar et al. (hereinafter referenced as "Baydar"), and U.S. Patent Application Publication. No. 2003/0081287 to Jansson et al. (hereinafter referenced as "Jansson")

CLAIM OBJECTIONS CLAIMS 1-16, 21, 22, AND-28

Claims 1-16, 21, 22, and 28 have been objected to for use of the phrase "capable of". Claim 9 has been objected to for a grammatical informality. The former objection is respectfully traversed.

MPEP §2106 states that, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." Even if the phrase, "capable of", were enumerated in either MPEP §2106 or 2111.04, it is noted that such a phrase "may raise a question as to the limiting effect of the language in a claim." *MPEP* §2106. In MPEP §2111.04, it is clear that, "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific

facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.’ *Id.*”

In a manner similar to the clause in the *Hoffer* case cited above, the phrase “capable of” introduces a limiting function of the claimed element immediately preceding the phrase. As such, the use of the phrase “capable of”, when read in context, cannot be interpreted as suggesting or making optional either the claimed element that it modifies or the function that it introduces. It is therefore submitted that the phrase, “capable of”, as used in the present application, provides patentable weight to the claims. It is respectfully requested that the objection to claims 1-16, 21, 22, and 28 be withdrawn.

Claim 9 has been amended to eliminate the typographical error. It is submitted that the ground for this objection has been obviated and that this objection should be withdrawn.

CLAIM REJECTION UNDER 35 USC § 112
CLAIMS 16-29

Claims 16-29 stand rejected under 35 USC § 112, second paragraph. Claims 16 and 23 are both independent claims. Both independent claims have been amended to provide sufficient antecedent basis for “the first packet diversion logic” and “the first packet diversion logic”. In view of the amendments above to these claims, it is submitted that independent claims 16 and 23 and dependent claims 17-22 and 24-29 are all allowable under 35 USC § 112. Withdrawal of this rejection is respectfully requested.

CLAIM REJECTIONS - 35 USC § 102
CLAIMS 1-15 AND 30-41

Claims 1-15 and 30-41 stand rejected under U.S.C. 102(e) as being anticipated by Fujisawa. This rejection is respectfully traversed.

Fujisawa does not present the buffering structure in claim 1. Fujisawa does not teach, show, or suggest any buffer or other storage device that is “adapted to store undiverted ones of egress packets.” Cell buffer 56 in Fujisawa stores all the ATM cells received by the line interface in contrast with the claimed structure in which three separate buffers are used to store the separated egress packets, namely, diverted egress packets, undiverted egress packets, and

insertion egress packets. See Fujisawa at col. 7, lines 39-47 and col. 8, lines 37-43. As presented in earlier in the prosecution of this application, Fujisawa's cell buffer is not "coupled between the first packet diversion logic and the first packet insertion logic". Instead, scheduler 16 provides read and write signals to cell buffer 56. Since both are input signals to the cell buffer, the buffer cannot be "coupled between the first packet diversion logic and the first packet insertion logic", as required by claim 1.

Since Fujisawa does not show each and every element as set forth in claim 1, it is submitted that claim 1 and claims 2-7, dependent directly or indirectly from claim 1, are allowable over Fujisawa. Withdrawal of this rejection is respectfully requested.

Independent claims 8 and 11 include the limitations similar to those discussed above with respect to claim 1. For all the reasons set forth above for claim 1, it is submitted that Fujisawa does not show each and every element as set forth in claims 8 and 11. Therefore, it is believed that claims 8 and 9-10, dependent from claim 8, and claims 11 and 12-15, dependent from claim 11, are allowable over Fujisawa. Withdrawal of this rejection is respectfully requested.

Similar to the limitations in claim 1, claims 30, 33, 36 and 39 call for separate storage structures for staging a type of egress packet. Moreover, claim 30 calls for a divert logic that is used "to selectively route egress packets into a selected one of said first and second storage structures", whereas claims 33 and 36 call for a divert logic that is used "to selectively route ingress packets into a selected one of said first and second storage structures". Fujisawa does not perform selective routing. Instead, Fujisawa routes all packets, whether ingress or egress, into the same cell buffer, either buffer 56 or buffer 66. For all the reasons set forth above for independent claims 30, 33, 36 and 39 and for the reasons provided above for claim 1 as it relates to these claims, it is submitted that Fujisawa does not show each and every element as set forth in claims 30, 33, 36 and 39. Therefore, it is believed that claims 30 and 31-32, dependent from claim 30, and claims 33 and 34-35, dependent from claim 33, and claims 36 and 37-38, dependent from claim 36, and claims 39 and 40-41, dependent from claim 39, are all allowable over Fujisawa. Withdrawal of this rejection is respectfully requested.

CLAIM REJECTIONS - 35 USC § 103
CLAIMS 16-20, 22-27, AND 29

Claims 16-20, 22-27, and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fujisawa in view of Baydar. This rejection is respectfully traversed.

Claims 16 and 23 are independent and includes limitations similar to those discussed above with respect to claim 1. Claims 17-20 and 22 depend directly from claim 16. Claims 24-27 and 29 depend directly from claim 23.

The deficiencies in the teachings of Fujisawa have been described above with respect to claim 1. Baydar does not provide any teaching that cures the deficiencies of Fujisawa. Baydar was added to the combination in order to provide teachings of the optical component, the electro-optical component, the data link/physical layer processing unit, and the body encasing these elements. Even so, the combination of Baydar and Fujisawa still fails to teach, show, or suggest the storage structures in claim 16 and the buffering structures in claim 23 as discussed above with respect to claim 1. Further, Baydar provides no teaching or suggestion of any datacom protocols called for in claims 22 and 23.

For the reasons set forth above, it is submitted that claims 16 and 23 and the claims dependent therefrom would not have been obvious to a person skilled in the art upon a reading of Fujisawa and Baydar, either separately or in combination. Therefore, it is submitted that claims 16-20, 22-27, and 29 are allowable under 35 U.S.C. §103. It is respectfully requested that this rejection be withdrawn.

CLAIM REJECTIONS - 35 USC § 103
CLAIMS 21 AND 28

Claims 21 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fujisawa in view of Baydar and further in view of Jannson. Claim 21 is dependent from claim 16 and claim 28 is dependent from claim 23. This rejection is respectfully traversed.

The deficiencies in the teachings of Fujisawa and Baydar have been described above with respect to claim 1. Jannson does not provide any teaching that cures the deficiencies of the combined references of Fujisawa and Baydar. Jannson was added to the combination in order to provide teachings of operation at data rates of at least 10 GB/s. In spite of the teachings of Jannson, the combination of Jannson with Baydar and Fujisawa still fails to teach, show, or suggest the storage structures in independent claim 16, from which claim 21 depends, and the

buffering structures in claim 23, from which claim 28 depends. Further, Baydar provides no teaching or suggestion of any datacom protocols called for in claim 23.

For the reasons set forth above, it is submitted that dependent claims 21 and 28 would not have been obvious to a person skilled in the art upon a reading of Fujisawa and Baydar and Jansson, either separately or in combination. Therefore, it is believed that claims 21 and 28 are allowable under 35 U.S.C. §103. It is respectfully requested that this rejection be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Gregory C. Ranieri, Esq. at (503) 439-6500 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3703.

Respectfully submitted,

Dated: **February 19, 2007**

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